Applicant notes with appreciation the acknowledgment of the claim for foreign priority and the indication that all of the certified copies of the priority documents have been received.

Applicant thanks the Examiner for considering the previously filed Information Disclosure Statement, PTO-1449 paper and cited references.

# II. Objection to the Drawings

The drawings were objected to under 37 C.F.R. 1.83(a). The Office Action states that roller bearing (claim 3), the X arrangement (claims 3 and 7) and the second angular roller bearing (claim 7) must be shown in the drawings or the features canceled from the claims.

37 C.F.R. 1.83(a) requires only that the drawings show features essential for the proper understanding of the invention. Applicant submits that the first bearing, including at least race 3 and bearing element 26, is shown in Figures 1 and 2. Applicant further submits that the second bearing and the X formation are readily understood based on the Specification, Figures and claims as filed and need not be shown for a proper understanding of the invention for the following reasons.

Transmission shaft 4 is mounted so it may rotate in a transmission housing 24 with the help of two pre-stressed tapered roller bearings arranged in an X formation relative to one another so they may rotate in a transmission housing 24, although only one tapered roller bearing 480 is illustrated. See page 4, lines 16 to 22. The right hand portion of housing 24, supported by the unshown second tapered roller bearing, is not shown for clarity. Given the stated X formation of the bearings, Applicant submits that the second bearing need not be shown for a proper understanding of the invention. The topmost bearing 26 in race 3 is shown angled down to the right. Given that it is stated that the shaft is mounted on two bearings, and given that the first bearing is on the left side of the transmission housing 11, it is readily understood that the second bearing is on the right of the first bearing. Further, given that it is stated that the bearings are in X formation, the topmost bearing in the second bearing race is readily understood as being angled down to the left. The X formation is formed by two pairs of bearings in two bearing races. Therefore, given that the second bearing and the X formation need not be shown for a proper understanding of the invention, Applicant submits that they need not be included in the Figures. Accordingly, withdrawal of the objection to the drawings is respectfully requested.

### III. Rejection of Claims 3 to 5, 7 and 8 Under 35 U.S.C. § 112

Claims 3 to 5, 7 and 8 were rejected under 35 U.S.C. § 112, second paragraph as indefinite for allegedly failing to particularly point out and distinctly claim the subject matter of the invention. The Office Action alleges that location and orientation of the roller bearing pair, the second angular roller bearing and the X arrangement is unclear. Applicant respectfully disagrees and submits that claims 3 to 5, 7 and 8 are sufficiently definite and allowable for the following reasons.

The second paragraph of 35 U.S.C. § 112 merely requires that the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. As provided in M.P.E.P. § 2173.02, the "focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph is whether the claim meets the threshold requirement of clarity and precision." In this regard, the "essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity." Id. (emphasis added). "Definiteness of claim language must be analyzed, not in a vacuum, but in light of[, inter alia, the] content of the particular application disclosure[ and the] claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made." Id. If the claims, when read in light of the Specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the second paragraph of 35 U.S.C. § 112 demands no more. M.P.E.P. § 2173.05(a) (citing Shatterproof Glass Corp. v. Libbey Owens Ford Co., 758 F.2d 613, 225 U.S.P.Q. 634 (Fed. Cir. 1985)).

As regards claim 3, which recites that the roller bearing pair are in an X arrangement, and claims 4 and 5, which ultimately depend from claim 3, it is respectfully submitted that the arrangement of a roller bearing pair in an X arrangement could not be more clear, particularly in view of the Specification, which states, for example, on page 4, lines 16 to 29:

Transmission shaft 4 is mounted so it may rotate in a transmission housing 24 made of a cast aluminum alloy with the help of two prestressed tapered roller bearings arranged in an X formation relative to one another so they may rotate in a transmission housing 24 made of a cast aluminum alloy, although only one tapered roller bearing 480 is illustrated. . . . In the X arrangement, a roller bearing outer race forms an angle which opens toward the inside of the transmission housing, so that the axial force component acting on the roller bearing outer race is

constantly pressing the roller bearing outer race against an axial contact surface 28 of transmission housing 24.

As regards claim 7, which recites that the roller bearing outer race includes a component of an angular roller bearing forming an X arrangement with a second angular roller bearing to support a transmission shaft, and claim 8, which depends from claim 7, it is respectfully submitted that the X arrangement and the second angular roller bearing could not be more clear, particularly in view of the foregoing cited portion of the Specification.

In view of the foregoing, it is respectfully submitted that claims 3 to 5, 7 and 8 fully comply with the requirements of 35 U.S.C. § 112, and withdrawal of this rejection is therefore respectfully requested.

## IV. Rejection of Claim 6 Under 35 U.S.C. § 102(b)

Claim 6 was rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 2,883,020 ("Kuemmich et al."). It is respectfully submitted that Kuemmich et al. do not anticipate claim 6 as amended herein for the following reasons.

Claim 6 relates to a roller bearing outer race. Claim 6 recites that the roller bearing outer race includes gearing engageable with a corresponding gearing and includes an arrangement configured for form-fitting torque transmission to a transmission housing.

Claim 6 has been amended herein without prejudice to recite that the gearing of the roller bearing outer race is arranged on a face of the roller bearing outer race. Support for this limitation may be found, for example, on page 5, lines 13 to 15 of the Specification.

Kuemmich et al. purportedly relate to a shifting device for claw clutches. The shifting device is stated to include a main shaft 10 supported by bearings 8 and 9 in a housing 11. See col. 2, lines 11 to 15. The outer race of bearings 8 and 9 do not include gearing engageable with corresponding gearing, as recited in claim 6, and do not include gearing arranged on a face of the roller bearing outer race, as recited in amended claim 6. Nor do the outer races of bearing 8 and 9 include an arrangement configured for form-fitting torque transmission to a transmission housing, as recited by claim 6. The Office Action alleges that Kuemmich et al. disclose a bearing outer race 9 configured for form fitting torque transmission to a housing 22, 21, 11. However, nowhere in Kuemmich et al. is there disclosure, or even a suggestion, of the roller bearing outer race comprising an arrangement configured for form-fitting torque transmission to a transmission housing, as recited in claim

6. The Office Action further alleges that bearing outer race 9 includes gearing 13 engageable with corresponding gearing. However, gearing 13 is stated to be connected to shaft 10 not bearing outer race 9 and not to a face arranged on bearing outer race 9. See col. 2, lines 15 to 17. Indeed, the Office Action admits that Kuemmich et al. lack "the teaching of the gearing being on the end face of the outer race of the bearing." See Office Action page 3, paragraph 9. Therefore, Applicant respectfully submits that Kuemmich et al. do not anticipate claim 6 as amended herein.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of Calif.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that Kuemmich et al. do not disclose, or even suggest, a roller bearing outer race including gearing arranged on a face of a roller bearing outer race engageable with a corresponding gearing and including an arrangement configured for form-fitting torque transmission to a transmission housing, as recited in amended claim 6.

Additionally, to reject a claim under 35 U.S.C. § 102, the Examiner must demonstrate that each and every claim limitation is contained in a single prior art reference. See, Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). Still further, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See, Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). In particular, it is respectfully submitted that, at least for the reasons discussed above, the references relied upon would not enable a person having ordinary skill in the art to practice the inventions of the rejected claims, as discussed above. Also, to the extent that the Examiner is relying on the doctrine of inherency, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied art." See M.P.E.P. § 2112 (emphasis in original); and see, Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or

characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, the anticipation rejection as to the rejected claims must necessarily fail for the foregoing reasons.

In summary, it is respectfully submitted that Kuemmich et al. do not anticipate amended claim 6.

## V. Rejection of Claims 1 to 5, 7 and 8 Under 35 U.S.C. § 103(a)

## A. Rejection of Claims 1 and 2

Claims 1 and 2 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kuemmich et al. Applicant respectfully submits that claims 1 and 2 are allowable for the following reasons.

Claim 1 relates to a parking lock mechanism for an automotive transmission by which a transmission shaft mounted with roller bearings is lockable with respect to a transmission housing. Claim 1 recites that the parking lock mechanism includes a roller bearing outer race and an axially displaceable body connectable in a rotationally fixed manner to the transmission shaft, the axially displaceable body lockable in a form-fitting and rotationally fixed manner with respect to the roller bearing outer race. Claim 1 has been amended herein to recite that the parking lock mechanism includes an arrangement configured to connect the roller bearing outer race in a form-fitting, rotationally fixed manner to the transmission housing; and

Claim 1 recites an axially displaceable body lockable in a form-fitting manner with respect to the roller bearing outer race. As indicated above, Kuemmich et al. do not disclose that clutch member 23 is lockable with respect to an outer race of bearings 8 or 9, nor for that matter, do they disclose that the clutch member 23 is lockable in a form-fitting manner. Claim 1 further recites a parking lock mechanism comprising a roller bearing outer race connected in a form-fitting rotationally fixed manner to a transmission housing. Support for this amendment may be found, for example, on page 4, line 29 to 35 of the Specification.

Nowhere do Kuemmich et al. disclose, or even suggest, that an outer bearing race of bearings 8 or 9 is connected to the transmission housing 11, nor for that matter, do they disclose an arrangement configured to connect an outer bearing race of bearings in a form-fitting rotationally fixed manner to a housing. Furthermore, Kuemmich et al. do not provide any suggestion or motivation to reconfigure bearings 8 or 9 so as to assure that clutch 23 is lockable in a form-fitting manner with respect to the an outer race of bearings 8 or 9 or

to provide an arrangement to connect the roller bearing outer race in a form-fitting, rotationally fixed manner to the transmission housing. Accordingly, Applicant respectfully submits that Kuemmich et al do not disclose all of the limitations of amended claim 1.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As stated above, Kuemmich et al. fail to disclose, or even suggest, each and every feature of amended claim 1. Specifically, Kuemmich et al. do not disclose, or even suggest, a parking lock mechanism including a roller bearing outer race, an arrangement configured to connect the roller bearing outer race in a form-fitting, rotationally fixed manner to a transmission housing, or an axially displaceable body lockable in a form-fitting manner with respect to the roller bearing outer race. It is therefore respectfully submitted that Kuemmich et al. do not render obvious amended claim 1.

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Moreover, it is respectfully submitted that the cases of *In re Fine*, *supra*, and *In re Jones*, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Office Action's generalized assertions that it would have been obvious to modify or combine the reference do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the reference relied upon. In particular, the Court in the case of *In re Fine* stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

Instead, the Examiner relies on hindsight in reaching his obviousness determination... One cannot use hindsight

reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

*In re Fine*, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of *In re Jones* stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill... would have been motivated to make the modifications... necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the present Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the reference to provide the claimed subject matter.

More recently, the Federal Circuit in the case of *In re Kotzab* has made plain that even if a claim concerns a "technologically simple concept" -- which is not the case here -- there still must be some finding as to the "specific understanding or principle within the knowledge of a skilled artisan" that would motivate a person having <u>no</u> knowledge of the claimed subject matter to "make the combination in the manner claimed," stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the

teachings in Evans, we conclude that the Board did not make out a proper <u>prima facie</u> case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

*In re Kotzab*, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Again, it is believed that there have been no such findings.

Accordingly, there is no evidence that the reference relied upon, whether taken alone, combined or modified, would provide the features and benefits of claim 1 as amended herein. is therefore respectfully submitted that amended claim 1 is allowable for these reasons.

As for claim 2, which depends from claim 1 and therefore includes all of the limitations of claim 1, it is respectfully submitted that Kuemmich et al. do not render obvious dependent claim 2 for at least the same reasons given above in support of the patentability of claim 1. <u>In re Fine</u>, <u>supra</u> (any dependent claim depending from a non-obvious independent claim is non-obvious).

As further regards claim 2, the Office Action admits that Kuemmich et al. do not disclose gearing on the end face of the outer race of the bearing. The Office Action alleges, however, citing Howard v. Detroit Stove Works, 150 U.S. 164 (1893), that it would have been obvious to one of ordinary skill at the time the invention was made to make the gearing 20 of transmission housing 11 and outer race of the bearing 9 of one piece, since it allegedly has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. The one piece cast stove grate in Howard v. Detroit Stove Works, was found unpatentable over a stove grate cast in two pieces because, according to the Supreme Court, "it involves no invention to cast in one piece an article which has formerly been cast in two pieces." Howard, 150 U.S. at 170. Applicant respectfully submits that providing gearing on the outer bearing race, as opposed to on the transmission housing, is not casting in one piece an article which was formerly cast in two pieces, nor for that matter, is it forming in one piece an article which has formerly been formed in two pieces, as the Office Action alleges. If the Office Action is alleging that previously claw 20 and bearing 9 were independent elements and that it is no invention based on Howard v. Detroit Stove Works to make a claw integrated with a bearing from what was once two separate elements, this reasoning is faulty and is a misapplication of the holding of Howard v. Detroit Stove Works, as claw 20 was never an original part of outer bearing race in the first place, i.e., the two parts were never originally "cast" or formed from two pieces.

Claw 20 is stated to be part of transmission housing 11 not bearings 8 or 9. See col. 2, lines 26 to 27. This is in contrast to the grate, found unpatentable in *Howard v. Detroit Stove Works*, which was a unitary body made from two separately cast parts. Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection and allowance of claim 2 is respectfully requested for this additional reason.

## B. Rejection of Claims 3, 4, 7 and 8

Claims 3, 4, 7 and 8 were rejected under 35 U.S.C. § 103(a) as unpatentable over Kuemmich et al. in view of U.S. Patent No. 5,800,072 ("Buch et al."). Applicant respectfully submits that the combination of Kuemmich et al. and Buch et al. does not render obvious the present claims for the following reasons.

Claim 3 and 4 ultimately depend from claim 1 and therefore include all of the limitations of claim 1, and claims 7 and 8 ultimately depend from claim 6 and therefore include all of the limitations of claim 6. As more fully set forth above, Kuemmich et al. do not disclose, or even suggest, all of the limitations of claim 1, from which claims 3, 4 ultimately depend, and Kuemmich et al. do not disclose, or even suggest, all of the limitations of claim 6, from which claims 7 and 8 ultimately depend. Buch et al. are not relied on for disclosing or suggesting the limitations of claim 1 or claim 6 not disclosed or suggested by Kuemmich et al. Indeed, Buch et al. do not disclose, or even suggest, the limitations of claim 1 and claim 6 not disclosed or suggested by Kuemmich et al. It is therefore respectfully submitted that the combination of Kuemmich et al and Buch et al. does not render obvious claims 3 and 4 for at least the same reasons given above in support of the patentability of claim 1 and that the combination of Kuemmich et al. and Buch et al. does not render obvious claims 7 and 8 for at least the same reasons given above in support of the patentability of claim 6. *In re Fine*, *supra* (any dependent claim that depends from a non-obvious independent claim is non-obvious).

The Office Action alleges that Buch et al. disclose an X-arrangement roller bearing pair on a transmission shaft for absorbing axial loads and that it would have been obvious to one of ordinary skill in the art at the time the of the invention to modify Kuemmich et al. such that it had an X-arrangement roller bearing pair. Applicant respectfully submits that Buch et al. do not disclose, or even suggest, bearings in an X-arrangement. Given the orientation of bearings 6 and 8 as illustrated in Figure 1, lines drawn through the bearings do not form an X. Rather, the bearings 6 and 8 are arranged in the opposite

orientation to an X arrangement. Therefore, Buch et al. do not disclose, or even suggest, the additional limitations recited in claim 3, 4, 7 and 8,

In view of the foregoing, it is respectfully submitted that the combination of Kuemmich et al. and Buch et al. does not render obvious claims 3 and 4, which ultimately depend from claim 1, or claims 7 and 8, which ultimately depend from claim 6.

## C. Rejection of Claim 5

Claim 5 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Kuemmich et al., Buch et al. and U.S. Patent No 4,782,719 ("Yarnell"). Applicant respectfully submits that the combination of Kuemmich et al., Buch et al. and Yarnell does not render obvious claim 5 for the following reasons.

Claim 5 ultimately depends from claim 1 and therefore includes all of the limitations of claim 1. As more fully set forth above, neither Kuemmich et al. nor Buch et al., either alone or in combination, discloses, or even suggests, all of the limitations of claim 1, from which claim 5 ultimately depends. Yarnell does not disclose, or even suggest, the limitations of claim 1 not disclosed or suggested by Kuemmich et al. or Buch et al. It is therefore respectfully submitted that the combination of Kuemmich et al., Buch et al. and Yarnell does not render obvious claim 5 for at least the same reasons given above. *In re Fine*, *supra* (any dependent claim that depends from a non-obvious independent claim is non-obvious).

Furthermore, claim 5 recites that the arrangement includes a pin connection including multiple pins configured to form-fittingly and rotationally fixedly support the roller bearing outer race. Yarnell purportedly relates to a shifter housing assembly for multiple speed power transmission. Abstract. None of the references cited by the Office Action, including Yarnell, disclose, or even suggest, a pin connection including multiple pins configured to form-fittingly and rotationally fixedly support the roller bearing outer race, as recited in claim 5. Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection and allowance of claim 5.

In summary, Applicants submit that claims 1 to 5, 7 and 8 are patentable over all of the references cited. Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection and allowance of claims 1 to 5, 7 and 8 is respectfully requested.

### VI. New Claims 9 and 10

New claims 9 and 10 have been added herein. It is respectfully submitted that new claims 9 and 10 do not add any new matter and are fully supported by the present application, including the Specification. It is respectfully submitted that these claims are allowable.

#### VII. Conclusion

Attached hereto is a marked-up version of the changes made to the claims by the current Amendment. The attached page is captioned "Version with Markings to Show Changes Made."

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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PATENT TRADEMARK OFFICE

### **VERSION WITH MARKINGS TO SHOW CHANGES MADE**

### IN THE CLAIMS:

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New claims 9 and 10 have been added.

Claims 1, 5 and 6 have been amended without prejudice as follows:

(Amended) A parking lock mechanism for an automotive transmission by which a ransmission shaft mounted with roller bearings is lockable with respect to a transmission housing, comprising:

a roller bearing outer race;

an arrangement configured to connect the roller bearing outer race [connected] in a form-fitting, rotationally fixed manner to the transmission housing; and

an axially displaceable body connectable in a rotationally fixed manner to the transmission shaft, the axially displaceable body lockable in a form-fitting and rotationally fixed manner with respect to the roller bearing outer race.

- 5. (Amended) The parking lock mechanism according to claim 4, [further comprising] wherein the arrangement includes a pin connection including multiple pins configured to form-fittingly and rotationally fixedly connect the roller bearing outer race with GRAPA 2 3 2003 CO the transmission housing, the transmission housing including a light metal cast part.
  - 6. (Amended) A roller bearing outer race, comprising:

an arrangement configured for form-fitting torque transmission to a transmis housing; and

a gearing arranged on a face of the roller bearing outer race engageable with a corresponding gearing.